

Marked-up text:

Fig. 6 is a flow chart showing the steps for making a donation in accordance with the present invention. Step 86 shows that a donor accesses home page 38 using Web browser 24 on a computer 16. Step 88 shows that the donor selects appropriate links to reach a donation screen shown in FIG. 9 [92]. For example, the donor may select[s] donor recognition page link 46 from home page 38 and then select a donate link 62 from donor recognition page 60. Upon selecting the donate link 62, the donor is connected to a secure area of server 20 to protect the confidentiality of personal and financial information that will be transmitted.

In the claims:

Amend claims 13, 17, 19, and 20 as follows:

B2 Sub C3 13. (Twice amended) The method of claim 12 in which publishing a donation list includes publishing a donation list arranged in order of donation level, the donation level corresponding to the total amount donated by each donor on the list, and further comprising displaying the level of donation required to achieve a specified position on the list.

Sub C4 B3 17. An apparatus for increasing charitable donations to an organization, the apparatus comprising:  
a network server for communicating with individuals over a computer network;  
first computer instructions executing on the network server to automatically accept donations over the computer network; and  
second computer instructions executing on the network server to automatically publish on the computer network information about the donation, thereby providing immediate recognition to the donor.

Sub C5 B4 19. The apparatus of claim 17 in which the first computer instructions publishes the information on a World Wide Web page on the Internet.

20. The apparatus of claim 17 in which the first computer instructions publishes an ordered list of donations.

Marked-up claims

13. (Twice amended) The method of claim 12 in which [the] publishing a donation list includes publishing a donation list [is] arranged in order of donation level, the donation level corresponding to the total amount donated by each donor on the list, and further comprising displaying the level of donation required to achieve a specified position on the list.

17. An apparatus for increasing charitable donations to an organization, the apparatus comprising:  
a network server for communicating with individuals over a computer network;

[a program] first computer instructions executing on the network server to automatically accept donations over the computer network; and

[a program] second computer instructions executing on the network server to automatically publish on the computer network information about the donation, thereby providing immediate recognition to the donor.

19. The apparatus of claim 17 in which the [program executing on the network server and automatically publishing information about the donation publishes] first computer instructions publishes the information on a World Wide Web page on the Internet.

20. The apparatus of claim 17 in which the [program executing on the network server and automatically publishing information about the donations publishes] first computer instructions publishes an ordered list of donations.

In the drawings:

Applicant submits a proposed change to FIG. 6 to correct two errors in the reference numbers. Applicant submits clean and marked-up drawings.

Remarks

Claims 6-28 are in the application. Claim 6, 17, and 21 are in independent form. No claims are allowed.

Request for Withdrawal of Final Rejection

Applicant submits that the finality of the rejection is improper. The Examiner states that applicant's amendment necessitated the new grounds for rejection. In applicant's February 22 Amendment, applicant amended claim 8 to add a period at the end of the claim and amended claims 13-15 to overcome indefiniteness rejections. There were no substantive changes to any claim. New claims were added.

In this Office action, all previously pending claims are rejected under newly cited art, new rejections are made under 35 USC 112 for unamended claims, and a new objection is made to the drawings.

Applicant submits that the previous amendment for indefiniteness did not necessitate new prior art rejections for all claims. The new 112 rejection of unamended claims and the new drawing objection of unamended drawings are also unrelated to applicant's previous amendment.

Drawings

The Examiner objects to the drawings for failure to show every step in the methods of claims 6 and claim 21. A drawing is required "where necessary for the understanding of the subject matter sought to be patented." 37 CFR 1.81(a); 35 USC 113. MPEP 604.01(f) states: "It has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first

sentence).” Applicant submits that no drawing is necessary to understand the method steps recited, and simply adding the claim words to a flow chart would not enhance understanding of the claimed invention.

Nevertheless, applicant submits that an embodiment of “automatically accepting” is shown in FIG. 6, steps 128 and 140, an embodiment of “automatically publishing” and “automatically and immediately making publicly available” is shown in step 140.

#### Rejection under 35 USC § 112

Claims 13 and 17-20 stand rejection under 35 USC § 112 for indefiniteness.

Claim 13 is amended to state a method step, and claim 17 is clarified by using the terms “first computer instructions” and “second computer instructions.” In today’s object-oriented programming environment, it can be meaningless to try to characterize a group of computer code as a single program or as multiple interacting programs. The amended language makes it unnecessary to characterize the computer instructions as one program or two.

#### Rejections under 35 USC 102

Claims 17-21 stand rejected under 35 USC § 102(e) as being anticipated by US. Pat. No. 5,864,604 to Moen et al.

Moen et al does not disclose “a program executing on the network server to automatically publish on the computer network information about the donation, thereby providing immediate recognition to the donor.”

The examiner states in paragraph 22 that the only positive limitations in claim 17 are a network server and a first program. The Examiner has ignored the function of the program because it fails “to add any structural limitations and are thereby regarded as intended use language.” Applicant submits that this is improper.

In WMS Gaming Inc. v. Int’l Game Tech., 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999), the Federal Circuit stated: “The structure of a microprocessor programmed to carry out an algorithm is limited by the disclosed algorithm. A general purpose computer, or microprocessor, programmed to carry out an algorithm creates ‘a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.’ In re Alappat, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) (en banc); see In re Bernhart, 417 F.2d 1395, 1399-1400, 163 USPQ 611, 615-16 (CCPA 1969) (‘[I]f a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged.’).”

The programming becomes part of the structure of the programmed computer and not merely an intended field of use. The prior art is not capable of performing the intended use, because the prior art was not so programmed. The Examiner’s position seems to be that the function of the program is not relevant, so all programmed computers are equivalent for purposes of patentability. This appears to be directly contrary to the Federal Circuit in WMS Gaming and Alappat.

The prior art does not teach a computer programmed to automatically accept donations over the computer network and to automatically publish on the computer network information about the donation, thereby providing immediate recognition to the donor. Thus, the prior art does not teach the claimed invention. Applicant requests that the anticipation rejection be withdrawn.

The examiner also states that applicant's claimed invention is not doing anything, it is merely capable of doing something. As described above, a computer that is programmed to perform a function is a special purpose apparatus and, like any other apparatus, a claim directed to it does not need to recite that the apparatus is doing something. When claiming a hammer, it is not necessary to claim that the hammer is hammering nails.

### Rejections under 35 USC 103

Claims 6-12, 16, 21, 22, 27, and 28 stand rejected under 35 USC § 103(a) for obviousness over either Moen et al., Ziarno '902, or Ziano 393, in view of U.S. Pat. No. 5,727,156 to Herr-Hoymann et al. The examiner states that Moen et al. discloses automatically accepting donations over a computer network and Herr-Hoymann teaches a system for publishing documents on the Internet.

In the Office's "Examination Guidelines for Computer-Related Inventions," (the Guidelines) the first step is to "Determine What Applicant Has Invented and Is Seeking to Patent." Section II. Claim 6, for example, is a method for increasing charitable donations. The Examiner is ignoring what applicant has invented and the claimed utility of the invention calling it "descriptive material not functionally involved in the steps of the method." Applicant submits that publishing a donor list is most certainly "functionally involved" in the process of increasing charitable donations. Accepting donations and publishing them provides immediate positive feedback and incentive for other to match the donation.

Not only is the information being published "functional," applicant submits that it is not proper to always ignore "non-functional information" as that term is used in the Guidelines. The Office's "Examination Guidelines for Computer-Related Inventions," section VI, states that a rejection is proper for "a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention." [Emphasis added]. The Guideline provides an example: "Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of non-functional descriptive material." In the present case, the prior art does not address the utility of the claimed invention. The prior art does not suggest a method of increasing charitable donations by providing immediate recognition and increasing competition between donors. The claimed invention is not simply a rearrangement of non-functional descriptive material.

In State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 U.S.P.Q.2d 1596, 149 F.3d 1368 (Fed. Cir. 07/23/1998), the Federal Circuit made clear that one cannot ignore steps of a method because they can be characterized as a business method, rather than something more "technical." The Federal Circuit said: "For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces an 'useful, concrete, and tangible result.' Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557. This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss." Although the court did not explicitly address § 103, if the useful result can be expressed as "non-functional information," it would not seem proper to ignore that information in determining patentability.

Herr-Hoymann describes a system for posting documents on the Internet. It does teach or

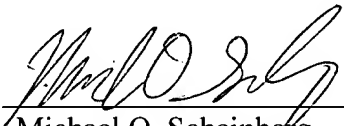
suggest posting automatically posting donation information to encourage further donations. Neither reference teaches publishing donor information to promote competition and increase donations. Applicant submits that it is only in hindsight from applicant's specification that the Examiner alters Herr-Hoyman and combines it with the other references to achieve applicant's invention.

The Examiner states that the claim elements missing in the combination of Moen and Herr-Hoymann are "descriptive material" and not functionally involved in the steps claims. Applicant disagrees for the reasons described above.

Applicant submits that the application is in condition for allowance and respectfully requests that application be granted.

Respectfully submitted,

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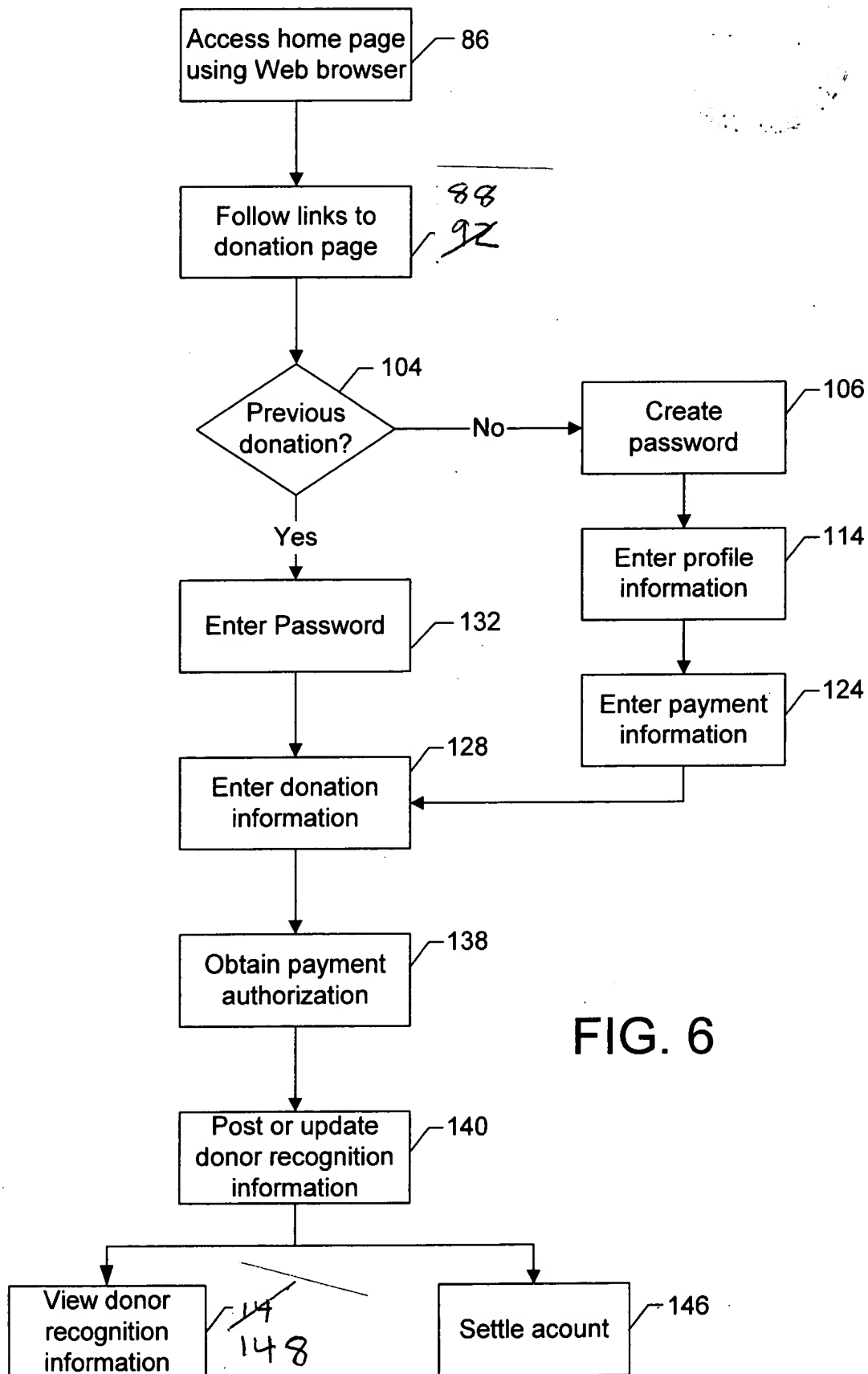


FIG. 6